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IN THE

Supreme Court of the United States

OCTOBER TERM, 1938.

No. 661

GENERAL ELECTRIC SUPPLY CORPORATION,

Petitioner,

vs.

THE MAYTAG COMPANY,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE EIGHTH CIRCUIT

and

BRIEF IN SUPPORT THEREOF

WILLIAM H. DAVIS,
DEAN S. EDMONDS,
CHARLES W. RILEY,
ROY P. SWANSON,
Counsel for Petitioner.

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PETITION FOR WRIT OF CERTIORARI

To the Honorable, The Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioner, General Electric Supply Corporation, prays that a writ of certiorari issue to review the decree of the United States Circuit Court of Appeals for the Eighth Circuit, entered December 15, 1938 (R. IV, 1898).

A certified transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith in compliance with Rule 38 of the rules of this Court.

Summary Statement of the Matter Involved.

This is a suit in equity brought by respondent against petitioner in the United States District Court for the Western District of Missouri for alleged infringement of patent 1,866,779, granted July 12, 1932, on an application of Howard F. Snyder, filed June 14, 1922. The Court of Appeals for the Eighth Circuit affirmed the decree of the District Court holding claims 23, 26, and 29 of the patent valid and infringed.

The Court of Appeals for the Second Circuit had previously held these claims (23, 26, and 29) invalid. *Maytag Company* v. *Hurley Machine Co., et al.*, and *Maytag Company* v. *Easy Washing Machine Corporation*, 96 F. (2d) 87. Petitions for certiorari filed in those cases by respondent were denied by this Court October 10, 1938. Subsequently, respondent filed petitions for rehearing in which the conflict between the decision in the instant case and the decisions in those cases was brought to the attention of this Court. On February 6, 1939, this Court granted a rehearing, vacated the orders denying certiorari, and granted the petition for writs of certiorari to the Circuit Court of Appeals for the Second Circuit. *The Maytag Company* v. *Hurley Machine Co. et al.*, and *The Maytag Company* v. *Easy Washing Machine Corporation*, Nos. 76 and 77, October Term, 1938.

In deciding the *Hurley* and *Easy* cases, the Court of Appeals for the Second Circuit referred to its earlier decision with respect to the same patent in *Maytag Company* v. *Brooklyn Edison Co., Inc.*, 86 F. (2d) 625. In the *Brooklyn Edison* case, plaintiff relied upon claims 23, 26, and 38, claim 38 being one of the three claims (claims 1, 38, and 39) of the patent directed to the method of washing clothes set forth in the specification. All three claims relied upon (23, 26, and 38) were held invalid by the Court of Appeals for the Second Circuit. This Court denied a petition for certiorari. *Maytag Company* v. *Brooklyn Edison Co., Inc.*, 300 U. S. 662.

Following the denial by this Court of a writ of certiorari in the *Brooklyn Edison* case, respondent filed a disclaimer in the patent office by which it disclaimed claim 38, and also disclaimed claim 1 (not relied upon in the *Brooklyn Edison* suit), asserting that the patentee had in those claims claimed more than that of which he was the original or first inventor (R. I, 12). The third method claim of the patent, claim 39, was not disclaimed. Neither is it relied upon in the instant case.

In the instant case petitioner denied the validity of claims 23, 26, and 29, denied infringement of claim 23, even if valid, and asserted that the patent is in any event wholly invalid because of respondent's failure or neglect to disclaim or attempt to vindicate the method claim 39 after becoming aware that the patentee had in that claim claimed more than he had invented or discovered.

Questions Presented.

The decision of the Circuit Court of Appeals for the Eighth Circuit presents the following questions:

1. Whether claims 23, 26, and 29 of the patent in suit are valid or invalid.

2. Whether claim 23, if valid, is infringed by the washing machines made and sold by petitioner.

3. Whether the patent is wholly invalid and unenforceable by reason of respondent's neglect to either disclaim claim 39 or make an effort to sustain it as valid in this suit.

Reasons for Granting the Writ

The discretionary power of this Court to grant a writ of certiorari is invoked upon the following grounds:

1. The decision of the Circuit Court of Appeals for the Eighth Circuit holding claims 23, 26, and 29 of patent 1,866,779 valid and infringed is in direct conflict with the decision of the Circuit Court of Appeals for the Second Circuit in the case of *Maytag Company* v. *Hurley Machine Co. et al.*, and *Maytag Company* v. *Easy Washing Machine Corporation,* 96 F. (2d) 87, holding the identical claims invalid.

2. The Court of Appeals for the Eighth Circuit erred in holding that infringement of claim 23 was conceded by petitioner, and thus deprived petitioner of its right to a review of that issue.

3. In holding that the patent in suit was not rendered invalid or unenforceable by reason of respondent's failure to disclaim claim 39, or to make any effort to sustain it as valid in this suit, the Court of Appeals for the Eighth Circuit has rendered a decision in apparent conflict with the decisions of this Court in *Ensten* v. *Simon, Ascher & Co.,* 282 U. S. 445, and *Triplett* v. *Lowell,* 297 U. S. 638.

WHEREFORE it is respectfully submitted that this petition for a writ of certiorari to the Circuit Court of Appeals for the Eighth Circuit should be granted.

WILLIAM H. DAVIS,
DEAN S. EDMONDS,
CHARLES W. RILEY,
ROY P. SWANSON,
Counsel for Petitioner.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinions of the Courts Below

The opinion of the United States District Court for the the Western District of Missouri was filed February 8, 1938. It appears at pages 553-61 of Vol. II of the record. It has not been reported. The opinion of the Circuit Court of Appeals for the Eighth Circuit was filed December 15, 1938. It appears at pages 1886-98 of Vol. IV of the record and is reported in 100 F. (2d) 218.

Jurisdiction

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by the Act of February 13, 1925, c. 229 (28 U. S. Code, Sec 347). The decree of the Circuit Court of Appeals for the Eighth Circuit which petitioner seeks to have reviewed was entered December 15, 1938 (R. IV, 1898). Thereafter, a petition for rehearing was filed (R. IV, 1899) which was denied on January 14, 1939 (R. IV, 1901).

Statement of the Case

The essential facts of the case are stated in the accompanying petition for a writ of certiorari. Any necessary elaboration of the facts will be made in the course of the argument which follows.

Specification of Errors

The errors which petitioner will urge, if the writ of certiorari is issued, are that the Circuit Court of Appeals for the Eighth Circuit erred:

1. In holding that claims 23, 26, and 29 of the patent in suit are valid and infringed.

2. In holding that claim 23 of the patent in suit is not limited to a specific construction not present in petitioner's machines.

3. In holding that the patent in suit was not rendered invalid or unenforceable by reason of respondent's failure to disclaim claim 39, or to make any effort to sustain that claim as valid in this suit.

4. In affirming the decree in favor of respondent entered by the district court.

Summary of Argument

The points of argument will follow the reasons relied upon for allowance of the writ of certiorari and will be discussed in the order set out in the petition (*ante*, p. 4).

ARGUMENT

I.

The decision of the Circuit Court of Appeals for the Eighth Circuit holding Claims 23, 26, and 29 of the patent valid and infringed is in direct conflict with the decision of the Circuit Court of Appeals for the Second Circuit in the case of Maytag Co. v. Hurley Machine Co. et al. and Maytag Co. v. Easy Washing Machine Corporation, 96 F. (2d) 87.

The conflict is clear. In each case the identical claims, and no others were involved. By one court they were held invalid and by the other they were held valid and infringed. The conflict was noted in the opinion of the Court of Appeals for the Eighth Circuit. This Court has taken

note of the conflict by granting certiorari in Nos. 76 and 77, the cases in which the Court of Appeals for the Second Circuit held the claims invalid.

II.

The Court of Appeals for the Eighth Circuit erred in holding that infringement of claim 23 was conceded by petitioner, and thus deprived petitioner of its right to a review of that issue.

One of the defenses asserted by petitioner in this case was that claim 23, even if valid, was not infringed by petitioner's accused machines. The ground upon which this defense is based is that the accused machines do not have the distinctive dish-shaped disc impeller called for by claim 23. Notwithstanding this defense was pressed upon the Court of Appeals for the Eighth Circuit, as shown by the extracts from petitioner's briefs set out in the petition for rehearing filed in the court below (R. IV, 1899-1901), the Court of Appeals for the Eighth Circuit proceeded on the mistaken assumption that infringement of claim 23 was conceded by petitioner (R. IV, 1887), and thus deprived petitioner of a review upon the issue of infringement of claim 23.

III.

In holding that the patent in suit was not rendered invalid or unenforceable by reason of respondent's failure to disclaim claim 39, or to make any effort to sustain it as valid in this suit, the Court of Appeals for the Eighth Circuit has rendered a decision in apparent conflict with the decisions of this Court in Ensten v. Simon, Ascher & Co., 282 U. S. 445, and Triplett v. Lowell, 297 U. S. 638.

The patent in suit originally contained three claims (claims 1, 38 and 39) defining in different terms the method of washing clothes described in the specifications. In *Maytag*

Co. v. *Brooklyn Edison Co., Inc.*, 86 F. (2d) 625, plaintiff charged infringement of claim 38. In that case the Court of Appeals for the Second Circuit held claim 38 invalid. This Court having denied a writ of certiorari in the *Brooklyn Edison* case, plaintiff disclaimed claim 38 and also disclaimed claim 1, asserting that through inadvertence, accident or mistake, the patentee had in those claims claimed more than that of which he was the original or first inventor or discoverer. The third method claim (claim 39) was not disclaimed. Neither is it relied upon in this suit.

It is petitioner's position that respondent's neglect to disclaim claim 39 or to make any effort to vindicate the claim in this suit renders the patent wholly invalid and unenforceable.

The Court of Appeals for the Eighth Circuit held that so long as the patentee continues in an attempt to vindicate his position with respect to *any* claims held invalid or with respect to other claims in the patent there is no necessity for filing a disclaimer (R. IV, 1896-8). This contention cannot be sustained in view of what was determined by the Court of Appeals for the Second Circuit in the *Brooklyn Edison* suit.

The question adjudicated in that case was whether the method of washing clothes described in the Snyder patent disclosed a patentable invention; and that issue was decided adversely to The Maytag Company. Upon reference to the opinion filed by the Court of Appeals for the Second Circuit in that case, it will be seen that the court analyzed the patent so far as it relates to an improved method of washing clothes, defined the method, and then proceeded to say that the art already knew how to wash clothes by that method (86 F. (2d) 625, 627). It thus appears that claim 38 was held invalid because the patent failed to disclose any method of washing clothes which would support any method claim.

It is obvious that if the patent discloses no novel method whatever, all method claims must be disclaimed. The defect was not cured by disclaiming claims 1 and 38. The

patent owner became aware at the time of the decision of the Court of Appeals for the Second Circuit in the *Brooklyn Edison* case that every method claim in the patent claimed more than that of which the patentee was the first inventor, and from that moment the patent owner had the duty either to seek vindication of the method claims or to give them up by disclaimer. It has failed to adopt either course. It has chosen, instead, to retain the method claim 39, holding itself out as the rightful possessor of the apparent monopoly defined by claim 39. It has made no effort to vindicate the claim by asserting it in this suit. We think this course of conduct, advantageous to respondent and injurious to the public generally, renders the patent invalid. This, we think, is the doctrine expressed and applied by this Court in *Ensten* v. *Simon, Ascher & Co.*, 282 U. S. 445. In that case it was said (p. 455):

> "In certain definitely defined circumstances, and to the end that the mistaken but honest inventor may obtain relief from the old rule, the disclaimer provisions permit him to deprive the public temporarily of complete freedom from the assertion of a monopoly apparently valid, but not so in fact. When a competent court has declared his pretentions without sufficient foundation, we think good faith and the spirit of the enactment demand that he act with such promptness as the circumstances permit either to vindicate his position or to relieve the public from further evil effects of his false assertion. But for the benign provisions of the statute, such an assertion would invalidate the whole patent; and these provisions were intended to protect only those who by prompt action either seek to overturn an adverse ruling or retreat from a false position."

The failure of respondent to disclaim claim 39 is not justified by anything in the decision of this Court in the case of *Triplett* v. *Lowell*, 297 U. S. 638. In that case this Court upheld the right of a patentee to relitigate in another

court claims which had previously been declared invalid. But it was specifically stated, citing *Ensten* v. *Simon, Ascher & Co., supra,* that a different question is presented where the claims adjudicated as invalid are abandoned, whether by a tardy disclaimer or otherwise, and a second suit is brought to restrain infringement of other claims (p. 646).

It is submitted that the court below, in holding that the doctrine of *Ensten* v. *Simon, Ascher & Co., supra,* has no application to the situation described above in view of the decision of this Court in *Triplett* v. *Lowell, supra,* failed to appreciate the purport of those decisions and reached a conclusion in direct conflict therewith.

CONCLUSION.

It is urged, therefore, that the petition for a writ of certiorari be granted.

Respectfully submitted,

WILLIAM H. DAVIS,
DEAN S. EDMONDS,
CHARLES W. RILEY,
ROY P. SWANSON,
Counsel for Petitioner.